

### **REMARKS**

Claims 1 and 3-32 are pending in this application.

Claims 1, 3-5, 8, 11, 13-19, 21, 24-26, 28-30 and 32 were rejected.

Claims 6, 7, 9, 10, 12, 20, 22, 23, 27, and 31 were objected to.

Claims 1, 15, and 24 are amended in this Response.

#### **Finality of the Rejection**

The Office Action states that “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**” Office Action, page 7. The finality of this rejection is improper.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

M.P.E.P. § 706.07(a) (emphasis added).

Applicant received the first Office Action in this case on May 25, 2005 and filed a reply that included an amendment on August 25, 2005. The Examiner advanced new grounds of rejection in the Office Action mailed September 16, 2005. The Office Action mailed September 16, 2005 included objections to the manner in which Applicant had presented marked-up claims in Applicant’s previous response. Applicant responded to that Office Action on December 16, 2005 by presenting arguments that the art of record did not render the claims unpatentable. Applicant’s December 16, 2005 response included claims that were marked as “currently amended”. These “amended” claims were only marked-up to overcome the objections to the claim marking from the Office Action mailed December 16, 2005. These same claim amendments were made in Applicant’s December 16, 2005 response. Only the method of marking-up the claim changes was different in the two responses. There is, therefore, no basis to claim that the marked-up claims in the December 16, 2005 response necessitated a new search.

Subsequently, on January 17, 2006 Applicant filed a Pre-Appeal Request for Review that resulted in prosecution being reopened on February 7, 2006. All of the rejections in the present Office Action are based on a new ground of rejection, U.S. Patent Application Publication 2002/0077875 A1 by Nadir ("Nadir"). The Examiner has been in possession of this reference at least since February 6, 2004, which Applicant submitted the reference in an Information Disclosure Statement. Making this Office Action final is improper under M.P.E.P § 706.07(a) and deprives Applicant of a proper chance to amend or argue in response to this new ground of rejection.

Applicant therefore requests that the finality of the Office Action mailed February 22, 2006 be withdrawn.

**Section 102 Rejections**

The Office Action states:

Claims 1, 3, 4, 5, 8, 11, 13, 14, 15, 16, 17, 18, 19, 21, 29, 32, 24, 25, 26, 28 and 30 are rejected under 35 U.S.C. 102(a) as being anticipated by Nadir (U.S. Patent Application Publication 2002/0077875).

Regarding claim 1:

Nadir discloses a material management system including: one or more waste containers adapted to receive and compact waste (abstract); a fullness-measuring subsystem for determining the fullness of one or more waste containers (fig. 1, page 2, section 0016-0026); a computerized scheduling subsystem in communication with the fullness-measuring subsystem for automatically determining an optimal time to empty each waste container (fig. 1, page 3, section 0028-0036), based the fullnesses of the waste container (fig. 15) and scheduling factors (page 3, section 0028-0036) including customer preferences (page 2, section 0016-0026) and waste hauler limitations (page 3, section 0028-0037).

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Regarding claim 15:

Nadir discloses a computerized method for scheduling a pick up time to remove of one or more waste containers, including, for

each waste container (abstract, fig. 1), automatically determining a fullness of the waste container (page 2, section 0015-0027); automatically determining when a waste container will reach a target level of fullness (page 2, section 0015-0027), based on the current fullness and predicted future usage (page 2, section 0015-0027, fig. 1); automatically determining an optimal time to remove the waste container (page 2-3, section 0015-0036), based on when the waste container will reach the target level of fullness (page 2, section 0015-0027), customer preferences (page 2, section 15-0027), and waste hauler limitations (page 2, section 0015-0027); and automatically scheduling the removal of the waste container for the optimal time (page 2-3, section 26-0036).

Regarding claim 24:

Nadir discloses a computer program, stored on a tangible storage medium, for use in scheduling a pick up time to remove one or more waste containers, the computer program including executable indications that cause a computer to (fig. 1), for each waste container (fig. 1); determine a fullness of the waste container; determine when the waste container will reach a target level of fullness (page 2-3, section 0023-0036), based on the current fullness and predicted future usage (page 2-3, section 0023-0036); determine an optimal time to remove the waste container (page 2-3, section 0023-0036), based on when the waste container will reach the target level of fullness (page 2-3, section 0023-0036), customer preferences (page 2-3, section 0023-0036), and waste hauler limitations (page 2-3, section 0023-0036); and schedule the removal of the waste container for the optimal time (page 2-3, section 0023-0036).

Office Action, pages 5-6.

Applicant respectfully disagrees. Nadir does not include any disclosure of customer preferences or waste hauler limitations, as required by the independent claims. The Office Action cited the following sections of Nadir to show customer preferences: page 2, section 0016-0026 (claim 1); page 2, section 15-0027 (claim 15); and page 2-3, section 0023-0036 (claim 24). None of these sections disclose “determining an optimal time to empty each waste container, based on . . . scheduling factors including customer preferences,” as required by claim 1. Claims 15 and 24 include similar limitations. Even considering the superset of all of

these cited sections of Nadir (sections 15-36) and giving “customer preferences” the broadest reasonable interpretation, there is no disclosure of this claim element in Nadir.

Nor does Nadir disclose “determining an optimal time to empty each waste container, based on . . . scheduling factors including . . . waste hauler limitations,” as required by claim 1. Claims 15 and 24 include similar limitations.

Applicant has amended claims 1, 15, and 24 to reinforce this lack of disclosure in Nadir and clarify what is claimed. Applicant requests that the amendments be entered and the case be allowed forthwith.

**SUMMARY**

Applicants contend that the claims are in condition for allowance, which action is requested. Applicants do not believe any fees are necessary with the submitting of this response. Should any fees be required, Applicants request that the fees be debited from deposit account number 02-0383.

Respectfully submitted,

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